



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/185,208	11/03/1998	MARK E. FAGAN	54537USA3A	5148

7590

11/29/2002

3M OFFICE OF INTELLECTUAL PROP COUNSEL
P O BOX 33427
ST PAUL, MN 551333427

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 11/29/2002

24

Please find below and/or attached an Office communication concerning this application or proceeding.

1. This is in response to the brief on appeal filed July 30, 2002.
2. **(1) *Real Party in Interest***
3. A statement identifying the real party in interest is contained in the brief.
4. **(2) *Related Appeals and Interferences***
5. A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.
6. **(3) *Status of Claims***
7. The statement of the status of the claims contained in the brief is correct.
8. **(4) *Status of Amendments After Final***
9. No amendment after final has been filed.
10. **(5) *Summary of Invention***
11. The summary of invention contained in the brief is correct.
12. **(6) *Issues***
13. The appellant's statement of the issues in the brief is correct.
14. **(7) *Grouping of Claims***
15. The appealed claims stand or fall together as stated by the Appellant.
16. **(8) *Claims Appealed***
17. The copy of the appealed claims contained in the Appendix to the brief is correct.
18. **(9) *Prior Art of Record***
19. The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

MAILED

NOV 26 2002

GROUP 1700

Art Unit: 1772

5,608,003 ZHU 03-1997

5,928,726 BUTLER 03-1999

20. **(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

(i) Claims 1-4, 7-8, 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (5,928,726) in view of Zhu (5,608,003).

Butler relates to a textured film having a layer of permanent adhesive on one surface and a layer of low adhesion backsize (LAB) on the opposite surface. The LAB is pattern-coated on the film and includes silica particulate as fillers. The coating can be 0.01 to 25 microns thick. The filler present is 0.1 to 20 percent. However, Butler fails to teach that the LAB coated film surface is visually uniform. Zhu discloses a coating composition of LAB comprising colloidal silica dispersion wherein the particle size can be larger that will not diminish LAB properties but changes the visual properties. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Zhu's teaching of using larger size silica particles in LAB in the invention of Butler to obtain visual uniformity of the film surface.

(ii) Claims 5-6, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler in view of Zhu and Blackwell (5,401,547).

Butler and Zhu, as discussed above, fails to teach the presence of two different LAB regions. Blackwell relates to a tape pad or roll comprising two different LABs on the back surface of the tape to facilitate removal and /or dispensing the tape from the pad or roll. Therefore, it would have been obvious to one having ordinary skill in the art to utilize

Art Unit: 1772

Blackwell's teaching of providing two different LAB patterns on the film in the invention of Butler.

21. Appellant's acknowledgement should be noted regarding Butler's patterned coating would be "visually uniform" anyway.

Appellant should note that "how to coat a film" was addressed in the FINAL OFFICE ACTION which was mailed on December 3, 2001. In said FINAL ACTION, the "how to coat a film" phrase was mentioned in response to Appellant's allegation that neither Butler nor Zhu teaches how to coat a film with LAB (low adhesion backsize).

As for appellants' argument that Zhu does not measure optical properties of his coatings. This is not deemed to be persuasive because, as acknowledged by the appellant, the coating being "transparent, translucent, or opaque" is directed to optical properties and its measurement. As for the reflective property, appellant failed to show that the opaque optical property would not provide for reflectivity aspect.

Once again, as had been addressed before in the FINAL OFFICE ACTION of December 31, 2001, appellant is reminded that the claims of the instant application fails to teach "coated and uncoated macroscopic portions of the film". This phrase cannot be read into the claims for the purpose of avoiding the applied prior art. When Butler's patterned coating is microscopic, said patterned coating would provide for uniform surface upon visual viewing. Appellant has failed to show that Butler's microscopic patterned coated surface would not provide for visually uniform surface.

Looking at Butler, it is clear that the pattern coating can be LAB, said coating pattern controls the appearance, surface texture, etc. The surface texture includes surface roughness.


Art Unit: 1772

Further, because Zhu teaches the use of larger size particles dispersed in the LAB coating that would provide for changes in visual properties in that the reflective characteristic would be effected. Since, Butler's pattern is microscopic, the presence of Zhu's particles would impart the reflective characteristic thereto and the coating would provide visual uniformity to the surface.

Regarding the Blackwell reference, it was cited to show that use of two different LABs is well known and would have been obvious to one of ordinary skill in the art. Responding to appellants' argument that Blackwell does not describe coated and uncoated portion, it must be realized that had Blackwell taught as argued, then Blackwell may have anticipated the claimed invention or replaced Butler as the primary reference. The teaching of Blackwell reference would provide for Butler to have LAB coatings using two different LABs on its film. Thus, the combination of Blackwell with Butler and Zhu would render said claims obvious.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


NASSER AHMAD
PRIMARY EXAMINER

November 15, 2002.

APPEAL CONFEREES:

HAROLD PYON 
SPE art Unit - 1772

CYNTHIA KELLY 
SPE Art Unit - 1774

3M OFFICE OF INTELLECTUAL PROP COUNSEL
P O BOX 33427
ST PAUL, MN 55133-3427